

REMARKS

To further prosecution of the present application, Applicants have amended herein Claims 15, 19, 21, 23, 24, 25, and 26. In addition, Applicants have cancelled herein Claim 22. Claims 15-21 and 23-26 are currently pending with Claims 15, 21, 23-26 in independent form.

Applicants respectfully request reconsideration.

Rejection of Claims 15-18 Pursuant to 35 U.S.C. § 102(a)

Claims 15-18 are rejected pursuant to 35 U.S.C. § 102(a) as being anticipated by U.S. 6,123,253 issued to Mehta et al. (hereinafter "Mehta"). Applicants respectfully traverse the rejection of Claims 15-18 for the reasons given below.

Applicants have amended herein Claim 15 directed to a one-piece mailer to include the limitation directed to:

a translucent area formed in the sheet between the first and second side edges, the translucent area formed in the sheet by a transparentizing process and configured with a receiving surface to receive printed data by a printing process, the translucent area being integral with the sheet and substantially continuous with at least one surface of the sheet.

Mehta does not disclose, teach, or suggest a transparentizing area that is integral with the sheet and substantially continuous with at least one surface of the sheet, as specified in Claim 15. Mehta discloses an address window 86 that may be a cut-out opening in the substrate (12) and may be covered by a translucent or clear film. (col. 6, lines 14-22; and Figures 1 and 2). In other embodiments, shown in Figures 4, 7, and 8, Mehta discloses the mailer may include an address area (74-b) (74-c) and (146), respectively. Mehta however does not disclose at least a translucent area formed by a transparentizing process. In addition, Mehta does not disclose a translucent area integral with the sheet and substantially continuous with at least one surface of the sheet. Mehta therefore does not disclose each and every element of Claim 15 as is required under § 102(a).

Claim 15 therefore is not anticipated by Mehta under § 102(a). Accordingly, Applicants respectfully request withdrawal of the rejection under § 102(a).

Claims 16-18 depend from Claim 15 and are patentable for at least the same reasons given above.

Rejection of Claims 19-26 Pursuant to 35 U.S.C. § 103(a)

Claims 19-26 have been rejected as being unpatentable over Mehta, as applied to Claims 15-18, and in further view of U.S. 6103,355 issued to Mehta (hereinafter “the ‘355 patent”).

Applicants have amended herein Claims 21 and 23-26 directed to a one-piece mailer to include the limitation directed to:

a translucent area formed in the sheet between the first and second side edges, the translucent area formed in the sheet by a transparentizing process and configured with a receiving surface to receive printed data by a printing process, the translucent area being integral with the sheet and substantially continuous with at least one surface of the sheet.

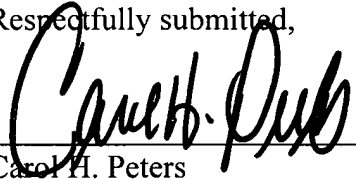
The ‘355 patent discloses a method of transparentizing a portion of a mailer and various transparentizing compositions. However, the ‘355 patent does not disclose, teach or suggest the translucent area formed in the sheet as specified in Claims 15, 21 and 23-26 in combination with the other limitations of these Claims. The ‘355 patent fails to disclose at least a mailer as specified in Claims 15, 21, and 23-26, such that, combining the teachings of the ‘355 patent with Mehta would not achieve the claimed inventions of Claims 15, 21, and 23-26. More particularly, the ‘355 patent fails to disclose at least the translucent area as specified in Claims 15, 21, and 23-26 to include a receiving surface to receive printed data by a printing process, such that, the combination of the teachings of the ‘355 patent with Mehta does not provide the claimed inventions.

The ‘355 patent also does not teach or suggest the translucent area as specified in Claims 15, 21, and 23-26, such that, one of ordinary skill would combine the teachings of the ‘355 patent to modify the mailer of Mehta to achieve the claimed inventions. Neither the ‘355 patent or Mehta disclose, teach or suggest a reason for combining the prior art references.

Thus, Applicants respectfully submit that the Office Action does not make a *prima facie* case of obviousness with the cited combination of prior art references and Claims 15, 21, and 23-26 therefore are not obvious in view of this combination.

Based upon the foregoing amendments and discussion, the present application is believed to be in condition for allowance, and a notice to this effect is earnestly solicited. Should the Examiner have any questions concerning this response, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



Carol H. Peters

Registration No. 45,010
MINTZ, LEVIN, COHN, FERRIS
GLOVSKY and POPEO, P.C.
Attorneys for Applicant
One Financial Center
Boston, Massachusetts 02111
Telephone: 617/348-4914
Facsimile: 617/542-2241

Date: November 6, 2008

ACTIVE 4468049v.1